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THE FARRELL LAW FIRM, LLP		
290 Broadhollow Road		
Suite 210E		
Melville, NY 11747		

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RECORD OF ORAL HEARING

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3   UNITED STATES PATENT AND TRADEMARK OFFICE

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6   BEFORE THE BOARD OF PATENT APPEALS

7   AND INTERFERENCES

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9   _____

10   Ex parte HYUN-JEONG KIM

11   _____

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13   Appeal 2009-006240

14   Application 09/734,852

15   Technology Center 2600

16   _____

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18   Oral Hearing Held: November 17, 2009

19   _____

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22   Before KENNETH W. HAIRSTON, MARC S. HOFF, and

23   BRADLEY W. BAUMEISTER, *Administrative Patent Judges.*

24

25   ON BEHALF OF THE APPELLANT:

26

27   MICHAEL J. MUSELLA, ESQ.

28   THE FARRELL LAW FIRM, LLP

29   290 Broadhollow Road

30   Suite 210E

31   Melville NY 11747

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33   The above-entitled matter came on for hearing on Tuesday, November

34   17, 2009, commencing at 9:00 a.m., at The U.S. Patent and Trademark

35   Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Courville,

36   Notary Public.

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1	P R O C E E D I N G S
2	THE USHER: Good morning. Calendar No. 44, Mr. Musella.
3	JUDGE HAIRSTON: Okay. Good morning, Counselor.
4	MR. MUSELLA: Good morning, Judge.
5	JUDGE HAIRSTON: Do you have a card so we can spell your name
6	correctly for the record?
7	MR. MUSELLA: Yes, I do. My name is Michael J. Musella,
8	M U S E L L A. I'm with The Farrell Law Firm, 290 Broadhollow Road,
9	Suite 210, Melville, New York 11747.
10	JUDGE HAIRSTON: You may begin.
11	MR. MUSELLA: Thank you. Okay, two independent method claims.
12	Each of independent claims 16 and 21 relate to a method of communicating
13	a confirmation message. In claim 16, the called party, the method
14	determines if the called party of the mobile station has confirmed the
15	received message. And then the called mobile station based on that
16	confirmation of the called party transmits a confirmation message to the
17	calling mobile terminal. So the communication in claim 16 is between the
18	called mobile terminal and the calling mobile terminal, and, and the
19	confirmation message is based on an action of the called party itself. Claim
20	21 also recites determining if a called-party of the mobile station has
21	confirmed the message, so again, the called party is, in fact, involved in that
22	process. And then the called mobile station generates the confirmation
23	message and transmits -- the called terminal again transmits the confirmation
24	message back to the calling mobile station.
25	In the, in the specification, there's, there's a little more detail that's
26	been provided, and the, the called mobile terminal checks whether the called

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1   party itself has read the text message and entered a key data related to the

2   confirmation message of the text message via the keypad. Again, the called

3   party must activate the, the terminal in order to make that confirmation.

4   There's an acknowledgement by the, by the called party itself. The

5   confirmation message includes information indicating that the called party

6   has, in fact, confirmed the received message. And then the called party will

7   transmit the confirmation message to the mobile switching center, which in

8   turn directly transmits it -- the confirmation message to the calling terminal.

9   JUDGE HAIRSTON: Counsel, does the specification make clear

10 what is meant by confirmation?

11   MR. MUSELLA: The specification states that the, that the

12 confirmation message is based on an action of the called party, that the

13 called party confirms the message. It's an action by the called party itself.

14   JUDGE HAIRSTON: Do you know what page that's on?

15   MR. MUSELLA: I -- it, it's on page 9, line 24, that's the, the -- not

16 the publication, but the actual --

17   JUDGE HAIRSTON: Thank you.

18   MR. MUSELLA: So then the called party is, is -- notifies the caller

19 whether he has confirmed the received message. The caller does not need to

20 transmit the message repeatedly, the calling party knows right away that the

21 called party has actually received and confirmed the message. So just in, in

22 brief steps, the calling terminal sends the message. The called terminal

23 receives the message. The called party confirms the message. The called

24 terminal then generates the confirmation message and the called terminal

25 transmits the confirmation message to the calling terminal. The

26 confirmation message as stated is a message that indicates that the user of

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1   the called mobile terminal has, in fact, acknowledged receipt of the message.

2   The confirmation message is based on the acknowledgement of the called

3   party, and it's transmitted from the called terminal directly to the calling

4   terminal without any need for request from the calling terminal. So the

5   calling terminal does not have to request anything, did you receive the

6   message or not.

7   Now the, the references, the rejections were based on -- for claim 16

8   on a combination of John, Itoh, and Choksi, and claim 21 are just joined in

9   Itoh. John in its abstract discloses a voice messaging systems that makes

10   available for a calling party the status of a voice message that's left for a

11   called party. In column, in column 4, lines 3 to 5, John specifically discloses

12   that the message and the status is stored on the voice messaging system, so

13   it's a separate system that's involved here, a third element, let's say that's

14   needed for the John system to operate. The message and the status is not

15   stored in either the calling mobile terminal or the called mobile terminal in

16   John. And then in column 4, lines 8 through 14, John specifically discloses

17   that the calling party must initiate and reestablish a connection with the

18   voice messaging system to review the status of the message. So again now,

19   this is the third, a third device or element that's required in the system of

20   John in order for this -- for the calling terminal to receive the, the status.

21   And, again --

22   JUDGE BAUMEISTER: Can I interrupt for a second?

23   MR. MUSELLA: Go ahead.

24   JUDGE BAUMEISTER: In, in the arguments, I thought they were

25   mostly directed towards what's the definition of a confirmation message?

26   Were there arguments in the Appeal Brief or the Reply Brief about whether

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1 there was -- whether it meant to read on sending a message to a storage

2 media versus being directly sent from the called party to the calling party?

3   MR. MUSELLA: Yes, I believe there was. On page 5, we're arguing

4 there that the -- of the, the agreement itself that claim 16 relates to the steps

5 of generating and transmitting by the called terminal the message indicating

6 the confirmation. And then transmitting the confirmation to the called

7 mobile terminal, and that, that Itoh there and John --

8   JUDGE BAUMEISTER: Okay, I see it now at the bottom of page 5.

9 It's generated and stored in a server, not directly transmitted to a calling

10 terminal. Okay, sorry.

11   MR. MUSELLA: That's quite all right. So that's how, you know,

12 that, that John -- to move on now to Itoh, Itoh discloses that a system

13 wherein a call[ed] mobile station verifies that it has just received the

14 message. So the system in Itoh does not take into account any confirmation

15 by the called party itself. It's only a receipt message, the called terminal is

16 the only thing that's involved in that process in Itoh, that's it's only the called

17 terminal that generates its received the message and sends a receipt message

18 back to the calling terminal. So again that's disclosed first in column 5 on

19 lines 2 to 3 and more broadly, lines 2 to 7, and only receipt of the message

20 is, is what's involved in the process of Itoh. And then if -- on Column 5, line

21 8, Itoh discloses that it's only after this verification process is, is undergone

22 that the message is actually read by the called party. And that's only after

23 that process does the called party actually get involved in the, in the process

24 of Itoh and nothing further is done in Itoh when the called party actually

25 reads its message. Choksi is only with respect to claim 16 and it discloses,

26 you know, that a confirmation message may include a telephone number.

1   So as previously stated, you know, the claims 16 and 21 recite the

2   steps of, again, generating and transmitting by the called mobile terminal

3   itself this confirmation message back to the calling terminal. A called

4   mobile terminal both generates and transmits a confirmation directly to the

5   calling terminal, and the confirmation message is only generated after the

6   called party confirms the message. Again, Itoh discloses that if a called

7   terminal receives a message from the calling terminal, the called terminal

8   transmits only this answering signal to enable the calling terminal to check if

9   the called terminal correctly receives the message. That is, the calling

10   terminal cannot check with the called party as confirmed and is actually

11   acknowledged receipt of the message, but can only check that the message is

12   received at the terminal itself. And although John teaches notifying a calling

13   party of the status of a message left for a called party, the status is only

14   generated in the server and can only be received by a calling party after a

15   request is made by that calling party. So the calling party has to engage in a

16   further process in order to determine whether or not there's any change in the

17   status of that.

18   Therefore, the combination of John and Itoh results in a process

19   wherein the called terminal confirms the message, and the message is

20   generated and stored in a server and not directly transmitted to a calling

21   terminal. Again, claims 16 and 21, when the called party confirms the

22   message, that is, it acknowledges receipt of the message, confirmation

23   message is directly transmitted to the calling party.   Therefore, it is not

24   necessary to store the confirmation message in a separate server as is

25   necessary in a combination of John and Itoh and/or Choksi.

1   Therefore, it is respectfully submitted that the rejections are incorrect

2 and that the independent claims are patentably distinct from the cited

3 references. And it is also requested that the rejections of independent claims

4 16 and 21 be reversed.

5   JUDGE BAUMEISTER: I have a couple questions. Regarding -- I

6 understand that the invention is -- the concept of the invention is to not need

7 this warehouse message storage place, that it's -- the confirmation is going to

8 be sent directly to the calling party. I'm looking in claim 16, though, and it

9 says -- if you have claim 16, transmitting from the called mobile station the

10 confirmation message to be delivered to the calling party wherein the

11 confirmation message is generated by the called mobile station when the

12 called mobile station has confirmed the received message and confirmed

13 message includes a telephone number of the calling mobile station. I don't

14 see anything in there saying that the confirmation message has to be sent

15 directly from the called party to the calling party. It's just that a

16 confirmation is generated, it could be sent and stored in a database for access

17 later by the calling party if they want to call and confirm?

18   MR. MUSELLA: Yes, and I understand how you're reading the

19 claim, but based on a disclosure in the written description, I don't think that

20 would be a reasonable interpretation of the claim to state that there is another

21 process. There is no other, there is no disclosure in the written description

22 that describes the claim as, as anything but transmitting from the called

23 mobile terminal directly to the calling mobile terminal.

24   JUDGE BAUMEISTER: But -- yeah, again, I understand what your

25 invention discloses, but nothing in, the method says comprising the steps of,

26 it's open-ended, it doesn't say where it's being sent to, that could be sent and

1   stored at some third machine. There's nothing to preclude it. It says, "to be

2   delivered," to me just means that's where it's ultimately would be delivered.

3   It doesn't say to be delivered directly by the calling party. Okay, but --

4   MR. MUSELLA: No, I understand how it's being read, and, you

5   know, based on the -- again, the written description, I don't think any -- an

6   interpretation that that confirmation message could go anywhere but the --

7   directly from the called terminal to the calling terminal in any analysis of the

8   Claim based on the written description. Although the claim -- I do

9   understand how you're reading it. I just don't think that the -- well, I know

10   that the written description does not support any, any interpretation that that

11   in fact, would cover -- that claim would cover any embodiment where there's

12   a separate entity in between where it's stored, the confirmation message.

13   JUDGE BAUMEISTER: Okay. The second question, I'm just trying

14   to clarify the meaning of the term confirmation following up from a previous

15   discussion before. So obviously there's a distinction between the called

16   party actively confirming versus the calling party calling to check again or --

17   sorry, bear with me one second. Okay, calling to confirm versus merely

18   being reviewed, only reviewing the message, but I -- so I guess would you

19   agree that if a called party picks up the phone and there is some mechanism

20   to automatically send back a response saying the called party has reviewed

21   this message, that would constitute a confirmation? I guess confirmation

22   doesn't require that the called party actually press a button or do some

23   additional step beyond just listening to the message, but if there was some

24   automatic -- no expectation from the phone?

25   MR. MUSELLA: Okay, I -- the calling -- the called party needs to

26   perform some sort of a function involved in, in the process. If the called

1   terminal just receives the message and the called party does nothing, the

2   confirmation message would not be generated. The called party must do

3   something, and disclosed in the specification are some examples of what a

4   called party could do. That could include actually reading the message, that

5   could include entering a button to say I have received this message, and I --

6   you know, but, again, it's the called party saying I've seen this. So the called

7   party must do something in order for the confirmation message to be

8   generated. Otherwise, the message will be sitting in the called terminal and

9   stay there unless and until the called party does some sort of a function.

10   JUDGE BAUMEISTER: Okay.   And regarding Choksi, did I

11 understand you correctly, that you agree that reference does disclose sending

12 a message, the confirmation message, that includes a telephone number?

13   MR. MUSELLA: Yes, I believe Choksi does correctly disclose that

14 there's a telephone number and a message that's sent.

15   JUDGE BAUMEISTER: Okay. If you could turn to Choksi, please.

16 I understand that it's generally primarily directed towards fax machines --

17   MR. MUSELLA: Correct.

18   JUDGE BAUMEISTER: -- but if you could turn to column 6.

19   MR. MUSELLA: Yes.

20   JUDGE BAUMEISTER: And let's see, reading along with me

21 starting at line 1, upon transmission of the notification message, the user,

22 i.e., associated with the transmitting facsimile machine (14), may receive a

23 confirmation message indicating that the facsimile message (12) was

24 successfully received by computer (18) and that the intended recipient of the

25 message has been notified thereof. Alternatively, or in addition, the user

26 may receive such a confirmation message after the intended recipient has

1   actually read, reviewed, or otherwise accessed to receive the facsimile

2   message, e.g., by accessing a Web site at which the message is available for

3   review as described in the above identified co-pending application. Now we

4   have a third alternative and still further embodiments. The intended

5   recipient of the facsimile message may choose to have a confirmation

6   message transmitted to the user. For example, if the after the intended

7   recipient has accessed the facsimile message by visiting a Web page as

8   discussed above, the user may notify computer (18) or another server where

9   the Web page is stored of successful reception of the facsimile message and

10   request that a confirmation message be transmitted to the user.

11   So again realizing this deals with facsimile machines, it does teach the

12   concept of sending a confirmation message.

13   MR. MUSELLA: Although it, it talks about a confirmation message,

14   in that, in that first embodiment that is disclosed there, the confirmation

15   message is only that the fax machine has received the facsimile. So, again,

16   that's analogous to the Itoh where the device is just confirming receipt of the

17   message or, in this case, the facsimile. The other two embodiments that are

18   disclosed there, specifically, again require this third system, this Web page

19   or for, for the parties to have to do and access and, and update I received I or

20   what's the status of it. So again, the, the facsimile machine in, in Choksi

21   does not actually acknowledge that the -- acknowledge directly to the

22   transmitting fax machine that the recipient has, in fact -- has the facsimile in

23   their hand whether they've read it or actually has it in their hands. They

24   have to, in fact, to this separate server, Web page, Web site in order to

25   receive it. So in that sense, it's analogous to John where that extra element

26   of the system is required, the third, the third element.

1   JUDGE BAUMEISTER: Okay, if you could bear with me while I

2 read claims 70 and 73, because I know claim 73 says the method of 70,

3 wherein the sending the confirmation message comprises transmitting the

4 confirmation message via e-mail. I don't see where they -- if that -- it reads

5 on directly. If one can interpret that as sending it directly.

6   MR. MUSELLA: Well, if I may, and e-mail could not be sent to the

7 X-machine I don't think. So now you're using it again as an additional

8 element that's required, an e-mail server, et cetera.

9   JUDGE BAUMEISTER: Okay, can we turn to column 8, though?

10   MR. MUSELLA: Eight. Yes?

11   JUDGE BAUMEISTER: I'm sorry. Let's see -- oh, okay, I'm sorry,

12 column 9, line 30.

13   JUDGE HAIRSTON: Which one was that?

14   JUDGE BAUMEISTER: Column 9, line 30.

15   JUDGE HAIRSTON: 30.

16   JUDGE BAUMEISTER: Beginning of the paragraph?

17   MR. MUSELLA: Yes.

18   JUDGE BAUMEISTER: Thus, an automated facsimile message

19 system has been described, although the present invention has been

20 discussed with reference to specific illustrated embodiments thereof, the

21 generality of the present invention should in no way be limited thereby. For

22 example, in additional to the above described embodiments, a subscriber-

23 based telecommunications message, e.g., voice or data system, configured in

24 accordance with the present invention may include a message reception

25 station configured to receive voice and/or data messages for a number of

26 subscribers and to notify each sender thereof of the successful receipt and/or

11

1   review of a message. Doesn't that -- it seems to me to indicate that this

2   applies to voice mails for messages and texts as well.

3   MR. MUSELLA: Yes, but, again, I think this is a separate system

4   that Choksi is describing here, the subscriber-based telecommunications

5   message system. It's separate from the -- from any receiving device,

6   whether it's the receiving facsimile machine or receiving telephone. This

7   again still requires that central system in order to manage all of this data and

8   for the calling party to receive information from and the called party to

9   access. So, it's again my understanding that there's a separate system that's

10   involved here.

11   JUDGE BAUMEISTER: Okay, but you would agree that under this

12   system, somebody can send a confirmation message that they've received

13   voice message or a text message to this third machine. And then the calling

14   party can call that third machine or system and verify that the called party

15   has reviewed the message?

16   MR. MUSELLA: Yes, I, I do believe that Choksi there does, does

17   allow for the sender to, to determine whether or not there was a success from

18   receipt and/or review of the message.

19   JUDGE BAUMEISTER: So it really seems to turn on whether the

20   claim language is narrowed, limited to require the called phone sending the

21   message directly to the calling phone or not?

22   MR. MUSELLA: Certainly one aspect that's being argued here, one

23   distinguishing feature of the claims, is certainly that the calling -- that the

24   called terminal directly sends a message to the calling terminal. And just to

25   go a little further, that -- although Choksi there does specifically say that the

26   successful receipt and/or review of the message, I don't want to right here

1 and now define what receipt and review are. I don't think -- I'm not sure if

2 receipt and review there would, in fact, read on our claims or not. So I

3 would refrain at least from this point how Choksi is, is defining receipt

4 and/or review there of the master chart. That's all I have.

5   JUDGE HAIRSTON: That's all, no questions. Thank you, counsel.

6   MR. MUSELLA: Thank you. Good day, judges.

7   (Whereupon, the proceedings, at 9:31 a.m., were concluded.)